

REMARKS

This is in full and timely response to the above-identified Office Action. The above listing of the claims replaces all prior versions, and listings, of claims in the application. Reexamination and reconsideration in light of the proposed amendments and the following remarks are respectfully requested.

Allowable Subject Matter

The allowance of claim 11 and the indication that claims 13 and 14 contain allowable subject matter, is noted with appreciation. Accordingly, claims 13 and 14 have been written into independent form and thus stand in *prima facie* condition for allowance.

Rejection under 35 USC § 102

The rejection of claims 9 10 and 12 as being anticipated by Harper (USP 6,675,316) is respectfully traversed. In this response, it is proposed to amend claim 9 to call for the access device to be connected to the external memory unit through a memory bus which is connected with the internal memory. Support for this amendment can be found in page 3, line 19 – page 6, line 5.

It is submitted that this amendment distinguishes over the disclosure of the coherency control chipset 101C which is "interpreted" as being the claimed, because it provides access to both the L3 cache and the external memory. It must be noted that the disclosure relating to the coherency control chipset 101C is very limited and that there is no disclosure or suggestion of the external and internal memory units and the access device being connected to the same memory bus so as to provide the claimed transparent access.

Without this disclosure, it must be submitted that a *prima facie* case of anticipation cannot be established.

Rejections under 35 USC § 103

The rejection of claims 15-17 as being unpatentable over Harper in view of Duso (Duso et al – USP 6,625,750), is respectfully traversed.

In order to establish a *prima facie* case of obviousness, it is necessary to show that the hypothetical person of ordinary skill would, without any knowledge of the claimed subject matter and without any inventive activity, be motivated to arrive at the claimed subject matter given the guidance of the cited references when each is fully considered as statutorily required.

It is further submitted that there are three possible sources for motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) This case law, however, establishes that, even if the combination of the references may possibly teach every element of the claimed invention, without a motivation to combine, a rejection attempting to establish a *prima facie* case of obvious must be held improper. Additionally, the level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

In this rejection it is acknowledged that Harper does not teach the external memory comprising at least two access server devices each connected to the access device of a host and a fault tolerant memory connected to each server device. To overcome this admitted shortcoming, Duso is cited as teaching a file server that contains stream servers which are "interpreted" as access server devices.

It is submitted that the "interpretations" which are made in connection with both the Harper and Duso disclosures, and on which this rejection are founded, are such as to render it untenable. "Interpretations" which can be made under § 102 are not available. The § 103 statute requires the disclosure of the references, when each is taken as a whole, be such as to lead the hypothetical person of ordinary skill to consider a transfer of teachings from one reference to another. The rejection is devoid of any indication as to what disclosure that is found in either of Harper or Duso that would be expected to motivate the hypothetical person of ordinary skill to make the above-mentioned "interpretations" with respect to the apparatus which constitutes the claimed "access device" and the claimed access server devices" and then consider a modification of the arrangement disclosed in Harper.

It is submitted that the mere assertion that stream servers are disclosed for connecting multiple hosts to memory is insufficient. This is merely a statement of what is disclosed by Duso. It is not reason to consider a transfer of teachings.

Applicant notes the position taken in the rejection that Harper expresses a desire to recover from faults that occur in a node of the network. It is however, clear that Harper provides an arrangement which satisfies this "desire." It is therefore asserted that this disclosed "desire" cannot be properly used as motivation to consider modification of Harper and to go and seek out a different (and unwarranted) solution.

Indeed, it would appear that the only guidance available to make the purportedly obvious modification would impermissibly come from the Applicant's own disclosure. Accordingly, as will be appreciated, the rejection fails to establish a *prima facie* case of obviousness.

Conclusion

Claims 9-12 and 15-17 are deemed to be allowable over the art for at least the reasons advanced above. Favorable reconsideration and allowance of these claims along with claim 11, 13 and 14, are respectfully requested.

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